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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,815	08/23/2000	Rei Asakai	Q60577	4168

7590 05/13/2003
Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037

EXAMINER

WRIGHT, SONYA N

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,815

Applicant(s)

ASAKAI ET AL.

Examiner

Sonya Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-36, 39 and 41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 20-36, 39, and 41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This is in response to Applicant's amendment filed 2-26-03. Claims 20-36, 39, and 41 are pending in this application.

The previous office action is vacated in view of the following: Due to the vastness of the claimed subject matter, further restriction of the claims is required. Accordingly, the following action is taken:

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Due to the numerous variables in the claims, e.g. R1, R2, R3, R4, R5, X, Y1, Y2, Y3, Y4, Z, etc. . . and their widely divergent meanings, a precise listing of inventive groups can not be made. The following groups are exemplary:

Group I claims 20-36, 39, and 41, drawn to compounds in formula (I) wherein X represents an oxygen atom; Z represents a halogen atom; R1 represents a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted, an acyl group which is substituted or unsubstituted; R2 represents a substituent on an indole ring, in which number and position (2-, 4-, 5-, 6-, or 7-position as position number of the indole ring) of the substituent and kind of the substituent may be the same or different, and represents a

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hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted; R3, R4 and R5 are absent; Y1 and Y2 are combined to form a carbonyl group; Y3 and Y4 are combined to form a carbonyl group; classified in class 548 and subclass 466.

Group II claims 20-36, 39, and 41 drawn to compounds in formula (I) wherein X represents N-R5; Z represents a halogen atom; R1 represents a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted, an acyl group which is substituted or unsubstituted; R2 represents substituent on an indole ring, in which number and position (2-, 4-, 5-, 6-, or 7-position as position number of the indole ring) of the substituent and kind of the substituent may be the same or different, and represents a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted; R3 and R4 are absent; R5 is an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, or an aryl group which is substituted or unsubstituted; Y1 and Y2 are combined to form a carbonyl group; Y3 and Y4 are combined to form a carbonyl group; classified in class 548 and subclass 466.

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Group III claims 20-36, 39, and 41 drawn to compounds in formula (I) wherein X represents an oxygen atom; Z represents the indole moiety containing R3 and R4; R1 and R3 independently represent a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted, an acyl group which is substituted or unsubstituted; R2 and R4 each represent substituent(s) on an indole ring, in which number and position (2-, 4-, 5-, 6-, or 7-position as position number of the indole ring) of the substituent(s) and kinds of the substituent(s) may be the same or different, and represents a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted; R5 is absent; Y1 and Y2 are combined to form a carbonyl group; Y3 and Y4 are combined to form a carbonyl group; classified in class 548 and subclass 455.

Group IV claims 20-36, 39, and 41 drawn to compounds of formula (I) wherein X represents N-R5; Z represents the indole moiety containing R3 and R4; R1 and R3 independently represent a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted, an acyl group which is substituted or unsubstituted; R2 and R4 each represent substituent(s) on an indole ring, in which number and position (2-, 4-, 5-, 6-, or 7-position as position number of the indole ring) of the substituent(s) and kinds of the

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substituent(s) may be the same or different, and represents a hydrogen atom, an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, an aryl group which is substituted or unsubstituted; R5 is an alkyl group which is substituted or unsubstituted, an alkenyl group which is substituted or unsubstituted, an alkynyl group which is substituted or unsubstituted, or an aryl group which is substituted or unsubstituted; Y1 and Y2 are combined to form a carbonyl group; Y3 and Y4 are combined to form a carbonyl group; classified in class 548 and subclass 455.

Again, this list is not exhaustive. It would be impossible to formulate a complete list under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, Applicant may choose to elect a single invention by identifying another group not listed in the exemplary groups of the invention, and the examiner will endeavor to group the same.

With the election of a specific exemplified group, a generic concept will be identified by the examiner as the inventive group for examination.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain an indolyl group of formula (I) with substituents R1, R2, R3, R4, R5, X, Y1, Y2, Y3, Y4, Z, etc. . . which does not define a contribution over the prior art. The substituents on the indolyl group vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking

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and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Moreover to not restrict herein, would impose a burden on the examination of this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

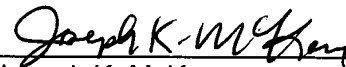
When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by

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the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 69.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

May 9, 2003